

REMARKS

Reconsideration of this application is respectfully requested in view of the foregoing amendment and the following remarks.

Initially, Applicant wishes to thank Examiner Michelle Tarae for the courtesies extended during the telephone interview of October 30, 2007, and for her gracious agreement to give Applicant one month from the filing of the Request for Continued Examination (filed October 31, 2007) to file an Amendment before she generates an Office Action on the instant application. This Amendment is being submitted in conjunction with the Request for Continued Examination for consideration by the Examiner and in compliance with the agreement.

Claims 7-9, 11-14, 42, 45-50, 52, 54-56, 59-63, and 65-79 were pending in this application. Claims 42, 56, and 66 have been amended hereby to further recite the invention, claims 80 and 81 have been added, and claims 49, 50, 63, 65, 77, and 79 have been canceled. Accordingly, claims 7-9, 11-14, 42, 45-48, 52, 54-56, 59-62, 66-76, 78, 80, and 81 will be pending herein upon entry of this Amendment. Claims 42 and 56 have been amended to include the previously presented subject matter of claims 77 and 79 and to further recite the "denoting" step of the invention, support for which can be found, for example, in the specification at page 17, lines 7-22. Claim 66 has been amended to address matters of form. For the reasons stated below, Applicant respectfully submits that all claims pending in this application are in condition for allowance.

In the Office Action mailed August 1, 2007, claims 7-9, 11-14, 42, 45-50, 69-74 and 76-79 were rejected under 35 U.S.C. § 103(a) as being unpatentable over www.jobasia.com and

Galewitz, Phil, "Desperate Hospitals Begging for Nurses," *Palm Beach Post*, Feb. 22, 1998 ("Galewitz"). Claims 52, 54-55, and 68 were rejected under 35 U.S.C. § 103(a) as being unpatentable over www.jobasia.com and Galewitz, and further in view of www.replyto.com. Claims 56, 59-63, and 65-67 were rejected under 35 U.S.C. § 103(a) as being unpatentable over www.jobasia.com and www.replyto.com and further in view of Galewitz. Claim 75 was rejected under 35 U.S.C. § 103(a) as being unpatentable over www.jobasia.com and Galewitz and further in view of Dossin et al. "Sign-on Bonu\$e\$ Score for Recruiters" ("Dossin"). To the extent these rejections might still be applied to claims presently pending in this application, they are respectfully traversed.

Claim 42 has been amended to further recite the invention. As recited in the amended claim, a method for placing applicants into jobs includes the steps of "denoting each job listing as being a listing for one of either a critical or a non-critical position, wherein denoting each job listing comprises: making a preliminary determination, by the employment placement service provider, as to whether each job listing is for a critical position or a non-critical position, wherein a critical position is one that is generally in high demand and for which only a small pool of applicants exists and a non-critical position is one that is generally easy to fill; and marking, in a database, each job listing as either a critical position or a non-critical position in accordance with the preliminary determination." Claim 42 has also been amended to recite, "wherein the job listings comprise non-critical positions and critical positions, and wherein the advertising fee is paid only for the critical hire positions that are filled and no advertising fees are paid by the employer in relation to the listing or filling of non-critical positions." Claim 56 has been

amended to recite similar features. Applicant respectfully submits that claims 42 and 56, and the dependent claims thereon, are patentable over the cited references for at least the reasons below.

Throughout the Office Action, the Examiner fails to establish a *prima facie* showing of obviousness. Generally speaking, it is improper to base the rationale for obviousness on an advantageous result of the claimed invention, such as improved efficiency or effectiveness, as the Examiner often does. If such a rationale were proper, any claimed approach that is in actuality novel and non-obvious could be deemed obvious solely by virtue of its result being more efficient or effective than conventional approaches. Rationale for obviousness must be based on the prior art and the knowledge of those of ordinary skill, and cannot be supported solely by the fact that an improvement would have been advantageous (*see, e.g.*, the rejection of claims 77 and 79 on page 15 of the Office Action, which uses advantages of the claimed invention, rather than specific teachings or understandings known in the art, to bridge the gap between the prior art and the claimed invention).

Even where broad general concepts are known in the art, such as the broad notion that signing incentives will increase interest in certain positions, these concepts are not specific enough to lead one of ordinary skill in the art to arrive at the particular method steps claimed. Applicant will address the particular rejections on an individual basis in the following but merely wanted to bring to the Examiner's attention at a preliminary stage the points that Applicant views as basic inadequacies in the rejections.

Regarding the step of denoting each job listing as one for either a critical or non-critical position in claim 42, Galewitz does not disclose, teach, or suggest this feature, and the Examiner

acknowledges that Jobasia does not do so (page 5 of Office Action). Galewitz is an article in a periodical that merely notes the fact that *hospitals* are paying signing bonuses to nurses, with higher bonuses going to nurses in higher demand areas. Galewitz does not comment at all on any sort of employment placement service provider or any structure of an interaction between such a provider and an employer. In Galewitz, there is no distinction made by an employment placement service wherein it is first determined whether a position is one that is generally in high demand and for which only a small pool of applicants exists or a position is one that is generally easy to fill, and then marking the job listing as one or the other in a database.

The step of denoting each job listing is fundamentally tied to further features of the claimed invention. As noted by the PTO in its *Guidelines for Determining Obviousness Under 35 U.S.C. 103 in View of the Supreme Court Decision in KSR International Co. v. Teleflex Inc.*, 72 FR 57526, 57428 (Oct. 10, 2007) (hereinafter referred to as "the Guidelines"), and in MPEP § 2141.02, the Examiner must consider both the invention and the prior art as a whole. Accordingly, the two-tiered structure as claimed, wherein applicants filling critical positions are paid signing bonuses from an advertising fee and applicants filling non-critical positions are entered into a prize pool and the employer *pays no fees* in relation to the non-critical positions, in conjunction with the remaining claim features, must be suggested by the prior art as a whole. Applicants respectfully submit that the prior art does not make any such suggestion. Where the Examiner uses various notions of common sense, business practice, or the like, it is most often in relation to one particular element of a claim. Even assuming for the sake of argument that these rationales may be proper with respect to the particular claim element, there is no showing by the

Examiner that each of these notions fit together to lead one of skill to the overall structure of the invention as claimed and, in fact, these notions appear to be contradictory at times.

The Examiner's Official Notice that "the use of incentives to encourage people to apply for certain job positions is old and well known," (page 6 of the Office Action) even if true, does not suggest to one of skill in the art to create the two-tiered placement structure as claimed. In particular, it does not suggest, with any degree of specificity, that one of skill would be inclined to divide job listings into the two groups as claimed, in the manner claimed, and to provide disparate treatment to each of the groups on two levels, the two levels of treatment being: (a) in relation to the incentives to the applicants, and (b) in relation to the incentives to the employers.

The applicant incentives (a) are different among the position types in that critical positions are awarded signing bonuses while non-critical positions are entered into a prize pool. The employer incentives (b) are different among the position types in that the employer pays advertising fees only upon the filling of critical positions and does not pay any fees in relation to the listing or filling of the non-critical positions. All of these features act together to form an employment placement system that uniquely and non-obviously provides incentives to each of the parties involved in a manner that is not suggested by the cited references.

For hires for critical positions, for example, the bonus may be much higher than the portion of the fees going to the placement service because the client can set the amount. For instance, if it is very difficult to find an operating room nurse in Montana, an employer/hospital might pay a total fee of \$10,000, with \$8,000 of that fee going to the nurse/applicant. Thus, the structure of the present invention is not set up like that which is described in the cited references,

wherein employers might simply pay a placement service a percentage of the yearly salary of the position listed upon hiring.

Claim 42 has been further amended to include the subject matter of claims 77 and 79 (now canceled) pertaining to the claimed feature that employers pay only upon the filling of critical positions and do not pay at all for non-critical positions. In the rejections of the former claims 77 and 79 on page 15 of the Office Action, the Examiner states that "it is old and well known in the art of the service industry to only charge for services that are rendered, or to only charge for services that are rendered to a customer's satisfaction." The Examiner then uses this statement as a rationale to motivate one of ordinary skill to only charge employers when jobs are filled.

Notably, the Examiner makes no mention of the features of (former) claim 79 (now included in claims 42 and 56), wherein no fees are collected upon the filling of non-critical positions. Naturally, this feature goes against the "old and well known" teaching stated by the Examiner since employers are actually receiving services for no charge at all, making the stated motivation entirely irrelevant to the particular features claimed. Since the motivation suggested by the Examiner is irrelevant and, at best, lacking in essential respects with regard to suggesting the claimed invention *as a whole*, Applicants respectfully request that any further rejections, if they are deemed necessary, include documentary support for any assertions of matters that are "old and well known in the art," matters of common sense, or takings of Official Notice, since Applicants do not believe that any such motivation or teaching can be expressed in such a form

that would lead one of ordinary skill to the unique two-tiered structure of the claimed invention taken as a whole. *See* MPEP § 2144.03.

Further, Applicants respectfully request an identification of which of the seven obviousness rationales set forth in the Guidelines the Examiner is using in support of each of the various grounds of rejection and an explanation of how the particular rationale is being applied, including an explicit explanation of each of the numbered findings required for each rationale set forth in the Guidelines. As stated in the Guidelines, quoting *KSR*, “rejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” 72 FR at 57528.

Applicants appreciate that the seven rationales set forth in the Guidelines are not all-inclusive. Accordingly, if the Examiner sees fit to apply an obviousness rationale that is not set forth in the Guidelines, Applicants nonetheless respectfully request a “clear articulation of the reason(s) why the claimed invention would have been obvious,” (*Id.*) which necessarily includes consideration of the claimed invention *as a whole* and is responsive, at the minimum, to the *Graham* factual inquiries as set forth by the Supreme Court and expounded on by the Guidelines and in the MPEP. Again, a rationale in accordance with the law includes an analysis of the differences between the claimed invention as a whole and the prior art, not a piecemeal assembly of various disparate rationales relating to individual elements of a single claim.

For at least the foregoing reasons, Applicants respectfully submit that claims 42 and 56 are patentable over Jobasia, Galewitz, and Replyto, alone or in combination. Claims 7-9, 11-14,

45-48, 52, 54, 55, 59-62, 66-76, 78, 80, and 81 are patentable at least by virtue of their dependency from claims 42 and 56 and for the additional features recited therein, several of which will be further discussed in the following.

The other references cited by the Examiner do not cure the deficiencies of Jobasia, Galewitz, and Replyto since they do not denote listings as critical or non-critical in the manner claimed and they do not provide the different claimed awards and fee structure based on that characterization.

In claim 9, it is recited that “providing employer information further comprises providing employer information about employers that are not posting job listings on the service.” In support of the rejection, the Examiner refers to reference A, page 4, presumably to the comment therein referring to the “Company Search” feature of Jobasia. That comment says, in its entirety, “Look up specific companies by name or by industry to find jobs.” It is not disclosed, taught, or suggested that information is available that relates to companies that *do not* have job postings on Jobasia. In fact, by its very terms, the description suggests that the ultimate goal is for the applicant to find a job listing by searching for a company and therefore only companies that have job listings will be searchable. In contrast, the present invention provides information about companies that *do not* have job listings posted on an employment service. In this manner, detailed and comprehensive information may be maintained and provided for all employers in a particular geographic area or even every relevant employer in the country, such as each of the more than 5,000 hospitals in the country. Regardless of whether a user is actually searching for a job, various employers and facilities can be researched and compared in accordance with the

present invention. Such features are not disclosed by the cited references and, as a result, claim 9 is patentable.

With respect to claim 14, the Examiner similarly broadly applies page 4 of reference A, referring to Jobasia. Claim 14 recites “storing particular employer information desired by multiple applicants; and analyzing the stored particular employer information to provide information as to demand for certain employer criteria.” Page 4 of reference A does not disclose, teach, or suggest this step. There is no reference therein to storing employer information desired by applicants and, further, there is no reference therein to using this information for analysis and providing information as to demand for certain employer criteria. In line with the principles governing obviousness rationales referred to above and in the Guidelines, further explanation is necessary in order to make a proper showing of obviousness.

New claim 80 recites claim features similar to those recited in claim 14, except that queries made by employers, rather than applicants, are stored and used for future analysis. Claim 80 further specifies that this analysis is used for the particular purpose of determining appropriate signing bonus amounts. None of the cited references discloses, teaches, or suggests these features and, therefore, claim 80 is patentable. Support for claim 80 can be found in the specification, for example, at page 10, lines 12-20, and page 34, lines 5-15.

New claim 81 further recites the invention by claiming that an unlimited number of job listings for non-critical positions is allowed to be broadcasted by the employment placement service without charging any fees to the respective employers in relation to the broadcasting or filling of the non-critical positions. No cited reference discloses, teaches, or suggests the

broadcasting and filling of certain job listings without charging fees and, therefore, claim 81 is patentable. Support for claim 81 can be found in the specification, for example, at page 17, lines 12-14.

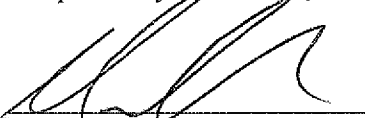
In view of the foregoing all of the claims in this case are believed to be in condition for allowance. Should the Examiner have any questions or determine that any further action is desirable to place this application in even better condition for issue, the Examiner is encouraged to telephone applicants' undersigned representative at the number listed below.

PAUL, HASTINGS, JANOFSKY & WALKER LLP
875 – 15th Street, N.W.
Washington, D.C. 20005
Tel: 202-551-1700

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Respectfully submitted,

By:



Michael Bednarek
Registration No. 32,329

MB/SPA/GS/ggb
Customer No. 36183